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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,405	04/14/2005	Ralf Heinrich Bode	821923-1030	5861
24504	7590	08/14/2007		
THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP 100 GALLERIA PARKWAY, NW STE 1750 ATLANTA, GA 30339-5948			EXAMINER WEINSTEIN, LEONARD J	
			ART UNIT 3746	PAPER NUMBER
			MAIL DATE 08/14/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 10/531,405	Applicant(s) BODE ET AL.	
	Examiner Leonard J. Weinstein	Art Unit 3746	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>04/14/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 11 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 11 is rejected recites the limitation of a method which is dependent upon an independent claim claiming an apparatus and fails to define the invention in the manner required by 35 U.S.C. 112, second paragraph. A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, 2nd paragraph. *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990).

4. Claim 12 provides for the use of compressor unit for compressing gas, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 12 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claims 1, 7, and 9 are rejected under 35 U.S.C. 102(a) as being anticipated by Lenderink et al. NL 1018212C. The international publication WO 02/099286 published in English is hereby cited for the purposes of referencing the any part of the written disclosure. Lenderink teaches all the limitations as claimed for a compressor including: a centrifugal compressor 1 for compressing a gas and an electric motor 4 having a stator 5 and a rotor 6 for driving the compressor 1, the compressor 1 and the electric motor 4 being accommodated in a common gastight housing 7 which is provided with a gas inlet 8 and a gas outlet 9, the stator 5 being accommodated in a separate stator space 21, which is delimited by, a wall section as shown in figure 2 of NL 1018212C and WO 02/099286, surrounding the stator 5, of the housing 7 of the compressor unit 1, a gastight partition 22 which extends between the stator 5 and the rotor 6 of the electric motor 4, and at least one end wall, as shown in figure 2 with element 22 connected with element 7 via a vertical wall extending in a radial direction from the are surrounding the element 6, which extends between the partition 22 and the housing 7 of the compressor unit 1, wherein the partition 22 extends freely between the stator 5 and the rotor 6 of the electric motor 4 and comprises a material of sufficiently high strength for it to remain clear of the stator 5 and the rotor 6 under working pressures of the gas which may occur inside the housing 7 (pg. 5 ll. 8-10 – WO 02/099286); a wall thickness of the

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partition 22 is greater at the ends than in the middle (pg. 5 ll. 23-26 – WO 02/099286); and a stator space 21 is provided with connections, elements 23 and 24, to a cooling unit, elements 25 and 26, for supplying and discharging a cooling medium (pg. 5 ll. 1-4 – WO 02/099286).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lenderink et al. NL 1018212C. Lenderink discloses the claimed invention except for a partition comprising a fibre-reinforced plastic. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a partition comprising a fibre-reinforced plastic in order to provide a wall of a stator chamber that is able to withstand a design pressure of a compressor. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

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10. Claims 3-5, 8 and 10 rejected under 35 U.S.C. 103(a) as being unpatentable over Lenderink in view of Brunet et al. 6,350,109. Lenderink teaches all the limitations as discussed but fails to teach the following limitations that are taught by Brunet including: a partition, elements 6a, 18, 61a, 114, 700, and 800, comprising an erosion-resistant layer, elements 114, 700, and 800 (col. 5 ll. 18-22) on the rotor 4 side; a partition comprising, elements 6, 18, 61, 114, 700, and 800, a gastight layer 18; a partition, elements 6, 18, 61, 114, 700, and 800, comprises a layer 61 of corrosion-free metal (col. 4 ll. 53-57); an end wall, comprised by elements 9 and 10, are separate parts, as shown in figure 1, which are connected to one another, via element 5, in a gastight manner by means of one or more sealing rings, elements 13 and 14; and a separate inner layer 61 and outer layer 6, on the rotor 4 and stator 111 side, respectively, at least the inner layer 61 having erosion-resistant properties (col. 4 ll. 53-57), at least one layer 6 having a high strength and at least one layer 18 being gastight. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify a protective sleeve provided between a stator and a rotor with a corrosion resistive coating or composition in order to protect a motor from the corrosive effects a of a working fluid (Brunet – col. 5 l.18-22).

11. Claim 6 rejected under 35 U.S.C. 103(a) as being unpatentable over Lenderink i.v. Brunet. A combination of Lenderink and Brunet teaches all the limitations as discussed except for a partition comprising a layer of polyaryl ether ketone. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a partition comprising a layer of polyaryl ether ketone in order to provide a wall of a stator chamber that is able to withstand a design pressure of a compressor. It has been held to be within the general skill of a worker in the art to

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select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Conclusion

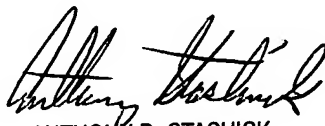
12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are cited on form 892 herewith.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leonard J. Weinstein whose telephone number is 571-272-9961. The examiner can normally be reached on Monday - Thursday 7:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on 571-272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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